

Attorney Docket No.: RTS-0302
Inventors: Monia and Watt
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REMARKS

Claims 1-20 are pending in the instant application. Claim 3 has been canceled. Reconsideration is respectfully requested in light of these amendments and the following remarks.

Claim 3 has been subjected to a Restriction Requirement under 35 U.S.C. §121 and 37 C.F.R. §1.141. The Examiner suggests that claim 3 specifically claims antisense oligonucleotides SEQ ID NOS: 16, 18, 20, 22, 26-28, 31, 32, 34-38, 40, 42-45, 47-55, 57-63, 66, 69-71, 74, 76, 77, 79-83, 85, 86 and 88, which are targeted to and modulate the expression of a nucleic acid encoding inhibitor-kappa B-R. Although the antisense sequences claimed each target the expression of the same gene, the sequences are suggested to be unrelated. It is suggested that each sequence is structurally and functionally independent and distinct. The Examiner has further suggested that a search of more than one of the antisense sequences recited in claim 3 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one of the claimed sequences. The Examiner suggests that one antisense sequence is considered to be a reasonable number of sequences for examination.

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Further the Examiner suggests that a search of databases produces a listing of references disclosing the sequence most similar to the query search. This is suggested to be the "place" where the Examiner searched for prior art. The Examiner indicates that prior art relating to another query sequence will not be found in this place and that a different listing of references must be generated and searched, thus making restriction proper.

Applicants respectfully traverse this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

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All of claims of the instant application relate to antisense modulation of Inhibitor-kappa B-R expression. Thus, Applicants respectfully disagree that the sequences as set forth by the Examiner are unrelated as suggested. Further, a search of literature relating to a compound 8 to 50 nucleobases in length targeted to a nucleic acid molecule encoding inhibitor-kappa B-R would clearly reveal art relating to all of the claimed sequences of claim 3. Thus, the inclusion of all of the sequences recited in claim 3 of this application would not be overly burdensome. Accordingly, the instant Restriction Requirement does not meet both of the criteria as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

However, in an earnest effort to be completely responsive to this restriction requirement and to facilitate prosecution of

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this application, Applicants have canceled claim 3 thereby
rendering the restriction requirement of the claim 3 sequences
moot.

Respectfully submitted,

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